

REMARKS

Claims 1-11, 14, 16-42 and 46-69 are pending in the above application. By the above amendment, claims 51-69 have been added.

The Office Action dated October 20, 2005, has been received and carefully reviewed. Each issue raised in that Office Action is addressed below.

REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH

Claims 18-34 were rejected under 35 U.S.C. 112, first paragraph, because these claims indicated that a subdisplay could be located on either the main body or the cover of a camera. As noted by the examiner, the drawing Figures show an embodiment of the invention having a subdisplay on the cover section. However, at page 25, lines 14-24 of the present application, it is provided that the subdisplay could alternately be provided on the main body section and that the lens could be provided on the cover section. It is therefore respectfully submitted that the specification supports the present scope of the claims, and the withdrawal of the rejection under 35 U.S.C. 112, first paragraph is respectfully requested.

REJECTIONS BASED ON KITAMURA IN VIEW OF KAWASAKI

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura in view of Kawasaki. Claim 1 requires an electronic device that includes, *inter alia*, a main body section and a cover section that are foldable. One of the inner surfaces includes an input key section and the other of the inner surfaces includes a first display. A lens section is provided on the outer surface of either the main body section or the cover section, and a second display section is provided on the outer surface of the other of the main body section and the cover section, that is, the one of the cover section and the main body section that does not include the lens section.

Kitamura shows a first lens 101 and a first display 106 on the "inside" of a camera and a second lens 102 on the outside of a camera. However, Kitamura's section display 107 is located with the second lens on the outside of the cover. Kitamura thus fails to satisfy the limitation that the second display be located on the other of the cover section and main body section. Therefore, not only does Kitamura not show a shutter button positioned as required by claim 1,

but Kitamura also fails to show a second lens and second display as required by claim 1. Thus, even if a motivation for adding Kawasaki's shutter body to the device of Kitamura were provided, Kitamura thus modified would lack the second lens and display defined by claim 1. For at least this reason, claim 1 is submitted to be allowable over Kitamura in view of Kawasaki.

Claims 2-11, 14, 16, 17 and 51-59 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura in view of Kawasaki. Claim 18 requires a foldable electronic device that includes a main body and a cover, wherein an inner surface of the main body includes an input key section and the inner surface of the cover includes a first display section. Claim 18 further requires that a lens section for the first camera be provided in an outer surface of the cover section and a second display be provided in the outer section of the main body section. Kitamura shows a camera and a display, both on a cover of an electronic device, contrary to the requirements of claim 18. Thus, even if a motivation for adding Kawasaki's shutter button to the device of Kitamura were provided, Kitamura thus modified would lack the second lens and display defined by claim 18. For at least this reason, claim 18 is submitted to be allowable over Kitamura in view of Kawasaki.

Claims 19-34 and 60 depend from claim 18 and are submitted to be allowable for at least the same reasons as claim 18.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitamura in view of Kawasaki. Claim 35 defines an electronic device having two "opposed surfaces" which face each other when the electronic device is folded. Sides opposite those opposed surfaces are discussed in the claim. Claim 35 requires a first image pick-up section on the opposite (outside) of a first member. Kitamura includes a first camera on the outside of the cover. Claim 35 requires that the second member have a display on the opposite side. Kitamura's second member, however, does not include a display on either side. Kitamura therefore does not show the invention required by claim 35.

The Office Action indicates that it would have been obvious to modify Kitamura to place a camera on the body section "such that the camera can be used during the folded state." However, Kitamura already discloses the use of the camera during the folded state (see Figure

9). Because Kitamura already functions in a folded state, there is no need to modify Kitamura to function in a folded state as suggested by the Office Action. While it might be possible to move Kitamura's camera, nothing in Kitamura or the art of record provides any reason for doing so. As provided by MPEP 2143.01, the fact that a modification is possible is not sufficient to establish a motivation for making the modification.

The Office Action also indicates that moving Kitamura's camera constitutes a mere rearrangement of parts and relies on *In re Japikse*, 86 U.S.P.Q. 70 (CCPA 1950) to show that such a rearrangement of parts is obvious. It is respectfully submitted that the holding in *Japikse* is not so broad. Note that MPEP 2144.04 in which *Japikse* is cited describes *Japikse* as holding something to be "unpatentable because shifting the position of the starting switch would not have modified the operation of the device (emphasis added)." Kitamura's camera can be used, essentially, as a mirror when folded as illustrated in Figure 9. Moving Kitamura's camera as suggested by the Office Action would modify the operation of the device and make the disclosed use impossible. Therefore, because the rearrangement of elements suggested by the examiner would modify the operation of Kitamura's device, it is respectfully submitted that the *Japikse* case is not applicable to the present facts. Moreover, MPEP 2144.04 goes on to quote the more recent *Ex parte Chicago Rawhide Mfg. Co.*, 223 U.S.P.Q. 351, 353 (BPAI 1984) which provides: "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." For these reasons, it is submitted that claim 35 is allowable over the references of record.

Claims 36-42, 46-50 and 61-69 depend from claim 35 and are submitted to be allowable for the same reasons as claim 35.

REJECTIONS BASED ON KAWASAKI IN VIEW OF KITAMURA

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki in view of Kitamura. The Office Action acknowledges that Kawasaki does not show first and second cameras as required by claim 1. However, the Office Action indicates that Kitamura shows two

cameras. As noted above, the fact that a second camera physically could be added to Kawasaki's device does not provide a motivation for doing so. MPEP 2143.01. The Office Action provides several reasons for modifying Kawasaki, but it is respectfully submitted that none of the reasons provides a motivation for modifying Kawasaki as done in the Office Action. First, the Office Action indicates that Kawasaki should be provided with a second camera "in order to enable[] a photographer to photograph a subject in various conditions while confirming a subject image." However, any camera with a viewfinder, including Kawasaki, can photograph a subject while confirming a subject image. See, e.g., Figure 4C of Kawasaki. No second camera is needed. Therefore, it is respectfully submitted that the above quoted statement does not constitute a motivation for modifying Kawasaki as done in the Office Action.

The Office Action also states that the proposed modification to Kawasaki would have been obvious because it is merely a rearrangement of parts, and cites the *Japikse* case for support. However, as discussed above 1) the modification cannot change the operation of the device and 2) a motivation for the rearrangement of parts is still required. *Ex parte Chicago Rawhide Mfg. Co.*, 223 U.S.P.Q. 351, 353 (BPAI 1984). No motivation for rearranging parts has been provided, and claim 1 is submitted to be allowable over Kawasaki in view of Kitamura.

Claims 2-11, 14, 16, 17 and 51-59 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki in view of Kitamura. Claim 18 requires a foldable electronic device that includes a main body and a cover, wherein an inner surface of the main body includes an input key section and the inner surface of the cover includes a first display section. Claim 18 further requires that a lens section for the first camera be provided in an outer surface of the cover section and a second display be provided in the outer section of the main body section. Claim 18 does not require a second or sub-camera as stated in the Office Action. However, claim 18 does require a lens on the cover section and a second display on the outside of the body section. These features are not shown in Kawasaki. No motivation for modifying Kawasaki has been provided. Claim 18 is therefore submitted to be allowable over Kawasaki in view of Kitamura.

Claims 19-34 and 60 depend from claim 18 and are submitted to be allowable for at least

the same reasons as claim 18.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki in view of Kitamura. The Office Action acknowledges that Kawasaki does not teach first and second image pick-up sections as required by claim 35. As argued above in connection with claim 1, a motivation for combining Kawasaki and Kitamura has not been provided, and therefore a *prima facie* case of obviousness has not been presented. Claim 35 and its dependent claims 36-42, 46-50 and 61-69 are therefore submitted to be allowable.

REJECTIONS BASED ON SATO

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (or possibly based on a combination of Sato and Kawasaki). Claim 1 requires an electronic device that includes, *inter alia*, a main body section and a cover section that are foldable. One of the inner surfaces includes an input key section and the other of the inner surfaces includes a first display. A lens section is provided on the outer surface of either the main body section or the cover section and a second display section is provided on the outer surface of the other of the main body section and the cover section, that is, the one of the cover section and the main body section that does not include the lens section. Sato shows first and second lenses on opposite sides of a cover. Sato does not show a second lens on the outer surface of the other of the main body section and the cover section as required by claim 1. The Office Action asserts that it would have been obvious to move Sato's camera in view of Kawasaki because this would allow the camera to be used in both a folded and unfolded state. However, Sato can already function in a folded (Figure 4) or unfolded (Figure 1) state. Moving the camera as proposed by the Office Action is not necessary to allow Sato to function in two states, and there is no reason to make this change. Moving the camera as proposed, however, will render Sato unusable for a disclosed purpose, namely using the camera as a mirror as illustrated in Figure 4. As provided in MPEP 2143.01, a proposed modification cannot render the reference unusable for its intended purpose. Therefore, a proper motivation for modifying Sato has not been provided. The rejections based on the *Japikse* case are traversed for the same reasons provided above. For these reasons, it is respectfully submitted that claim 1 is allowable over the art of record. Claims 2-11, 14, 16, 17

and 51-59 depend from claim 1 and are submitted to be allowable for at least the same reasons as claim 1.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (or as being unpatentable over Sato in view of Kawasaki). Claim 18 requires a foldable electronic device that includes a main body and a cover, wherein an inner surface of the main body includes an input key section and the inner surface of the cover includes a first display section. Claim 18 further requires that a lens section for the first camera be provided in an outer surface of the cover section and a second display be provided in the outer section of the main body section. As discussed above, the Office Action has not provided any motivation for making the proposed modification to Sato. Claim 18 and its dependent claims 19-34 and 60 are submitted to be allowable for at least the same reasons as claim 18.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (or Sato in combination with Kawasaki). As argued above in connection with claims 1 and 18, the Office Action has not identified a proper motivation for modifying Sato in the manner proposed in the Office Action. Claim 35 is submitted to be allowable for the same reasons as claim 1. Claims 36-42, 46-50 and 61-69 depend from claim 35 and are therefore submitted to be allowable for the same reasons as claim 35.

CONCLUSION

Each issue raised in the Office Action dated October 20, 2005, has been addressed, and it is believed that claims 1-11, 14, 16-42 and 46-69 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/791,851
Amendment dated February 21, 2006
Reply to Office Action of October 20, 2005

Docket No.: 1248-0702P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


Dated: February 21, 2006

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